



Paper No. 6

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OFFICE OF PETITIONS

In re Application of
DiDomenico & Rendahl
Application No.: 09/704,565
Filed: November 3, 2000
Attorney Docket No.: 23439-034-402
For: REMOTE EMISSIONS SENSING SYSTEM
AND METHOD WITH A COMPOSITE BEAM
OF UV AND IR RADIATION THAT IS NOT
SPLIT FOR DETECTION

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed October 16, 2001.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on November 3, 2000 without an executed oath or declaration. Accordingly, on March 16, 2001, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on October 16, 2001, a declaration executed by joint inventor Rendahl and Attorney Christopher J. Cuneo on behalf of Envirotest Systems Corporation (ESC), a company with proprietary interest in the invention, a statement establishing ESC's proprietary interest, the surcharge, a five month extension of time with required fee, and the instant petition and required fee were filed. A declaration of facts of Attorney Christopher Cuneo and a declaration of facts of Niranjan Vescio accompanied the petition. Attorney Cuneo states that Devin Morgan, an agent of the firm previously responsible for the prosecution of this application, sent a letter to inventor DiDomenico's last known address. It was returned marked as unclaimed. Niranjan Vescio states that the joint inventors are currently working for a direct competitor of ESC.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks items (1) and (2) above.

As to item (1), Applicant has failed to establish that the inventor refused to sign the declaration.

The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events. Attorney Cuneo states that Devin S. Morgan sent a letter to Mr. DiDomenico at his last known address and it was returned unclaimed. The letter sent by Devin S. Morgan states that a copy of the issued patent, the reissue claims and the reissue declaration were enclosed. These documents do not pertain directly to the above-identified application. The Office requires that the non-signing inventor be provided with a complete copy of the application as filed. This includes the specification with claims, drawings, if any, and a declaration. See MPEP 409.03(d). Finding a refusal based on conduct is possible. However, more than one attempt to obtain the inventor's cooperation in the filing of the application is typically necessary.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The declaration submitted with the instant petition was signed by one of the inventors. Attorney Christopher Cuneo signed an addendum to the declaration on behalf of ESP, a company with proprietary interest.

An empowered representative of an entity with proprietary interest may sign the declaration only when no inventor is available. In this instance, inventor Rendahl signed the declaration. Therefore, the declaration with Attorney Cuneo's signature is not acceptable.

The signing inventor must sign the declaration for the application of behalf of himself and on behalf of the non-signing inventor. The declaration will be acceptable if the signing inventor signs in his signature block and the signature block of the non-signing inventor is left blank **OR** if the signing inventor signs a document that states he is signing on behalf of the non-signing inventor. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47(a) applicant on behalf of Mr. DiDomenico is REQUIRED. See MPEP 409.03(a).

It appears that petitioner has submitted documents with the intention of having an entity with a proprietary interest intervene and make the application on behalf of the non-signing inventor. Petitioner is reminded that when one joint inventor signs, the provisions of 37 CFR 1.147(a) apply. Where 37 CFR 1.137(a) is available, application cannot be made under 37 CFR 1.147(b). MPEP 409.03(b)

Further correspondence with respect to this matter should be addressed as follows:

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